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10/574,681

04/04/2006

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12/23/2009

EXAMINER

DEXTER, CLARK F

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

12/23/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/574,681 | <b>Applicant(s)</b><br>FELDER, SACHA |  |
|                              | <b>Examiner</b><br>Clark F. Dexter   | <b>Art Unit</b><br>3724              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 2,7-9,11-18,22,23,26 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,10,19-21,24,25 and 28-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The amendments filed on January 7, 2009, April 29, 2009 and August 18, 2009 have been entered.

#### ***Election/Restrictions***

2. Applicant's election without traverse of Group II (claims 1, 3-6, 10, 19-21, 24, 25 and 28-30) in the reply filed on April 29, 2009 is acknowledged. Claims 2, 7-9, 11-18, 22, 23, 26 and 27 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

#### ***Drawings***

3. The drawings were received on April 29, 2009. These drawings are acceptable.

#### ***Claim Objections***

4. Claims 29 and 30 are objected to because claim 29 depends from itself which is improper. For examination purposes, claim 29 has been considered as depending from claim 28.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 3-6, 10, 19-21, 24 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure does not provide support for the tool comprising a housing and a barrel grip. Rather, support is provided for a barrel grip that is part of the housing.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

7. Claims 1, 3-6, 10, 19-21, 24 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 2-3, the recitation “embodied separately” is vague and indefinite as to what is being set forth; in lines 6-8, the recitation “or is both substantially round-shaped and has a cross section permitting it to be grasped around by one hand of an operator” renders the claim vague and indefinite since it appears to be redundant with respect to lines 4-6.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Knouse et al., pn 2,263,136.

Knouse discloses a tool with every structural limitation of the claimed invention including:

a housing (e.g., the portion connected to A including 25 as viewed in Fig. 1), a barrel grip (e.g., A), a detachable top handle (e.g., 10), which is embodied separately from said barrel grip, and an attaching device (e.g., the fasteners such as 23 shown in Fig. 1) for attaching said top handle (12) to said housing, wherein said detachable top handle (12) is substantially round-shaped, has a cross section permitting it to be grasped around with one hand of an operator, or is both substantially round-shaped and has a cross section permitting it to be grasped around by one hand of an operator;

[claim 3] wherein an on-off switch (e.g., 30, 32) is at least partially integrated into said top handle.

10. Claims 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Worobec, Jr., pn 3,873,796.

Worobec discloses a tool with every structural limitation of the claimed invention including:

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a handle (e.g., 20),  
an on-off switch (e.g., 80) at least partially integrated into said handle, and  
a locking mechanism for locking said on-off switch,  
wherein said locking mechanism has at least two at least largely decoupled  
actuating elements (e.g., 108, 126);  
[claim 29] wherein said actuating elements are situated on opposite sides of said  
handle;  
[claim 30 (from 29)] wherein said actuating elements are comprised of separate  
components.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 4-6 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable  
over Knouse et al., pn 2,263,136 in view of Worobec, Jr., pn 3,873,796.

Knouse discloses a tool with almost every structural limitation of the claimed  
invention but lacks a locking mechanism as follows:

[claim 4 (from 3)] wherein a locking mechanism for locking said on-off switch is  
integrated into said top handle (12);

[claim 5 (from 4)] wherein said locking mechanism has at least two at least largely decoupled actuating elements;

[claim 6 (from 5)] wherein said actuating elements are situated on opposite sides of said top handle;

[claim 19 (from 5)] wherein said actuating elements are configured so that they are actuatable directly by a user;

[claim 20 (from 5)] wherein said actuating elements are comprised of separate components;

[claim 21 (from 5)] wherein said actuating elements are arranged to provide a device useable for left-handers and right-handers with same requirements.

However, the Examiner takes Official notice that such locking mechanisms are old and well known in the art and provide various well known benefits including facilitating constant operation of the tool without having to maintain contact/pressure on the switch. Many examples are commonly found on hand tools including saws and drills. One example of such a locking mechanism is disclosed by Worobec, wherein Worobec also teaches that the locking mechanism prevents inadvertent actuation of the tool. Therefore, it would have been obvious to one having ordinary skill in the art to provide such a locking mechanism on the device of Knouse for the well known benefits including those described above.

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13. Claims 10, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knouse et al., pn 2,263,136.

Knouse discloses a tool with almost every structural limitation of the claimed invention but lacks a second on-off switch integrated into the barrel grip as follows:

[claim 10 (from 3)] wherein the on-off switch ( ) at least partially integrated into the top handle (12) is at least in part integrally joined to a second on-off switch ( ) at least partially integrated into the barrel grip ( );

[claim 24 (from 10)] wherein said part which is integrally joined with said on-off switch of said top handle and with said second on-off switch of said barrel grip is configured as an electrical switch;

[claim 25 (from 10)] wherein a detent mechanism comprises a retaining tab which locks said second on-off switch when said top handle is attached to said housing.

However, the Examiner takes Official notice that such on-off switches that are at least in part integrated into the barrel of a tool are old and well known in the art and provide various well known benefits including providing a simpler connection configuration wherein the switch is directly mounted with the motor and wherein the switch does not involve other components of the tool such as the handle(s) and thus facilitates easier replacement/repair of those other components. Therefore, it would have been obvious to one having ordinary skill in the art to provide such an on-off switch configuration on the barrel of Knouse to gain the well known benefits including those described above.



**Remarks**

14. It is noted that in the previous Office action on the merits (mailed October 2, 2008), the rejection under 35 USC 112, 1<sup>st</sup> paragraph (paragraphs 5-6 of the Office action) was inadvertently placed in the subject Office action but clearly does not pertain to the present application and thus should with ignored.

**Response to Arguments**

15. Applicant's arguments filed January 7, 2009 have been fully considered but they are not persuasive.

In the last paragraph on page 13 of the subject response, applicant argues that

*"The Knouse patent does not disclose that the gripping portion which forms the rear handle (12) and the gripping portion which builds the top handle (10) are embodied separately from each other. Therefore, the present invention as defined in new Claim 1 is novel over the Knouse reference."*

The Examiner respectfully disagrees and to the extent understood takes that position that Knouse discloses all of the structure of the claimed invention.

In the third paragraph on page 14 of the subject response, applicant argues that Knouse "does not disclose each and every element in the present invention as now defined in Claim 1." However, it is respectfully submitted that applicant has not clearly pointed out how claim 1 structurally distinguishes over Knouse; that is, applicant has not pointed out what claimed structure is not present in Knouse. It is respectfully submitted that the recitation "separately embodied" to the extent understood is met by Knouse in that the barrel portion of Knouse and the handle(s) of Knouse are clearly separate

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components that are mounted together. Therefore, it is respectfully submitted that Knouse discloses all of the claimed structure.

It is noted at this time that the issue of whether Knouse teaches the actual act of gripping the barrel portion is of little patentable moment. The barrel of Knouse is fully capable of being gripped and therefore using the barrel portion as a gripping portion is a functional recitation of intended use that does not clearly imply any additional structure and thus cannot be relied upon to distinguish the claimed invention over the prior art.

In the last paragraph on page 16 of the subject response, applicant argues that "the Knouse patent does not show that the handle (D) could be attached tool-free." The Examiner respectfully disagrees with applicant's analysis. Clearly, Knouse teaches attachment means in the form of screws 23 which are clearly fully capable of being tightened to at least some extent without tools (i.e., by hand).

For at least the above reasons, it is respectfully submitted that the prior art rejections must be maintained.

### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/  
Primary Examiner, Art Unit 3724**

cfd  
December 18, 2009